

Appl. No. 09/759,107
Amdt. Dated April 11, 2005
Reply to Office action of April 4, 2005

REMARKS / ARGUMENTS

A. **Generally**

Claims 17-29, 49, and 51 are pending in the Application. Claim 17 has been amended.
Claims 49 and 51 were allowed.

B. **Claim Rejections**

CLAIM REJECTIONS - 35 USC §112

Claims 17-29 have been rejected under 35 USC §112 first paragraph as failing to comply with the enablement requirement. Applicant has amended claim 17 as suggested by the examiner to correct this deficiency.

CLAIM REJECTIONS - 35 USC §102

Claims 17-29 have been rejected under 35 USC §102(e) as being unpatentable over U.S. Patent 6,438,217 to Huna (herein, "Huna"). Applicant previously argued that Huna was not prior art because the inventions claimed via claims 17-29 were presented in the specification of U.S. Patent 6,483,900. The '900 Patent was characterized by Applicant as the parent of the present application and predates the 102(e) data of Huna.

As to claim 17-29, the examiner determined that the '900 Patent did not disclose the phrase "alphanumeric message" and therefore could not support the claims of the present application prior to the filing date of Huna.

Applicant has subsequently determined that the reference to the '900 Patent as the parent of the present application was in error. The present application as filed was a continuation in part of application no. 08/963,373, filed October 20, 1997, now U.S.P. 6,175,616. Applicant regrets any inconvenience this error may have caused.

The '616 Patent clearly discloses the concept of an "alphanumeric message." Claim 5 of the original claim set that was filed with the application recites:

5. The system for obtaining telephone status over a network of claim 1 further comprising:
 - a called party processor connected to the network;
 - a voice mail converter connected to the called party processor for converting an alpha numeric message to a voice mail message;
 - the converter further connected to a called party telephone for allowing a called party to access the voice mail message; and
 - whereby the calling party processor can create an alphanumeric message

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to be sent to the called party processor over the network for subsequent conversion into voice mail by the voice mail converter.

(Underlining added.)

It is well settled that the original claims are part of the disclosure.

In addition, early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description); accord *In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); accord *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. MPEP §2163 8th Ed. (Rev.2)

In addition, the examiner found that Huna taught a creation device comprising wireless devices and telephones. The examiner determined that as the '600 Patent (misidentified by Application as the Parent of the present Application), did not "refer to wireless PCs (PC was the only email message creation device recited therein) nor of telephones (wireless or otherwise) sending or 'enabling a user to' create alphanumeric messages or 'email'. Reference to creation device being other than a PC and wireless was first disclosed on page 6 paragraph numbered 25 of the instant application." The examiner appears to be holding that unless the specification explicitly discloses the wireless means and a creation device means other than a PC, Applicant may not claim inventions using those means. Applicant respectfully submits that the law is otherwise.

The '616 Patent discloses a calling party sending an email (a message that the examiner acknowledges is a form of alpha-numeric message) to a called party. In the Background of the Invention Section, the present invention is described as providing "a method and apparatus for sending an e-mail to the desired party for storage as a voice mail message." ['616 Patent, Col. 1, lines 23-25.] In the Description of the Invention Section, an embodiment of the present invention is said to allow a calling party to "elect to alert the called party that a call was attempted, to send an e-mail and have the e-mail delivered as a voice mail message, or to be signaled when the called party's phone is on-hook." ['616 Patent, Col. 2, lines 55-59.] Additionally, the Description of the Invention Section of the present application states that a "further embodiment of the present invention is to use the calling party computer to send the called party an e-mail and to have the e-mail converted to voice mail and delivered to the called

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party's voice mail box." ." ['616 Patent, Col. 3, lines 26-29.] In the Detailed Description of the Invention section of the present application, an embodiment is disclosed wherein "the calling party may also send an e-mail to the called party's computer 34." ['616 Patent, Col. 4, lines 30-31.]

According to 35 U.S.C. § 112, ¶ 1 (1994), a patent specification must contain a written description of the invention sufficient to "allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." See, e.g., *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479, 45 USPQ2d 1498, 1503 (Fed.Cir.1998) (quoting *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed.Cir.1989)), as quoted in *Johnson Worldwide Associates, Inc., v. Zebco Corporation and Brunswick Corporation* 175 F.3d 985, 993.

The standard for claim construction was clearly stated by the court in *Golight, Inc., v. WAL-Mart Stores, Inc.*, 355 F.3d 1327, (Fed.Cir.(Colo.)):

In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use 'to particularly point[] out and distinctly claim [] the subject matter which the patentee regards as his invention.' " *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed.Cir.2001) (quoting 35 U.S.C. § 112, ¶ 2). While claims must be construed in light of the specification, *Markman*, 52 F.3d at 979, limitations from the specification are not to be read into the claims, *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed.Cir.1998), for "[i]t is the claims that measure the invention," *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed.Cir.1985). The written description may, however, restrict the scope of the claims if "the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed.Cir.2002). *Golight*, 355 F.3d 1331.

Applying this standard to the present application, it is clear that there is no evidence that the Applicant intended to deviate from the ordinary and accustomed meaning of the terms used in the disclosure. As pointed out above, the specification describes sending an email. As known in the art at the time of the invention, an email could be created by any number of devices, including a computer, a personal digital assistant, or even a telephone. It was also known to those skilled in the art that an email message could be sent over wired and wireless media. Without an expression from the Applicant that a particular means and a particular media were critical to the invention, the examiner is prohibit from reading limitations into the claims.

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The court in *Golight* arrived at the same conclusion based on the facts before the court:

We see no clear definition or disavowal of claim scope in the written description of the '989 patent that would limit claim 11 to horizontal rotation through 360°. While it is true that the patentees describe their invention as having the ability to rotate through 360°, this particular advantage is but one feature of the invented search light. The written description describes other significant features as well, such as the use of a particular wireless remote control and differing mechanisms for attaching the search light to the roof of a vehicle. The patentees were not required to include within each of their claims all of these advantages or features described as significant or important in the written description. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1370 (Fed.Cir.2003) ("An invention may possess a number of advantages or purposes, and there is no requirement that every claim directed to that invention be limited to encompass all of them."); *SRI Int'l*, 775 F.2d at 1121 ("If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims."). *Golight*, 355 F.3d 1331.

The court in *Golight* also made clear that an inventor is not required to disclose all possible embodiments of an invention. In footnote 4, the court stated:

Nor do we find the disclosure of a single embodiment to be limiting in this case. An applicant is not necessarily required by 35 U.S.C. § 112, ¶ 1 to describe more embodiments than its preferred one, and we have outright rejected the notion that disclosure of a single embodiment necessarily limits the claims. *See Teleflex*, 299 F.3d at 1327 (stating that "the number of embodiments disclosed in the specification is not determinative of the meaning of disputed *1332 claim terms"). Moreover, "[a]bsent a clear disclaimer of particular subject matter, the fact that the inventor anticipated that the invention may be used in a particular manner does not limit the scope to that narrow context." *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1301 (Fed.Cir.2003). *Golight*, 355 F.3d 1331-1332.

The '616 Patent is clearly not limited in scope as suggested by the examiner. Quite the contrary, the scope of the '616 Patent disclosure is expressly not limited. For example, at Col. 3, lines 53-57, the disclosure states:

Using a personal computer or other similar type of processor 12 a calling party accesses a network, in this case the Internet 10, although the invention is not so limited. Any network that can be connected to a calling party and a called party can also be used. [Emphasis added by underlining.]

The term "computer" is clearly not meant to be limiting:

It should be noted that while the term "computer" is used in the present specification, it is

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anticipated to be within the scope of the present invention to have special purpose equipment to accomplish the specific tasks and functions described below. '616 Patent, Col. 3, lines 21-25.

For these reasons, Applicant submits that the parent to the present application, the '616 Patent, clearly supports claims 17-29 and that they are allowable over Huna. Additionally, as to claim 26, the disclosure of the '616 patent clearly describes an embodiment in which a computer is used as a creation device:

A further embodiment of the present invention is to use the calling party computer to send the called party an e-mail and to have the e-mail converted to voice mail and delivered to the called party's voice mail box. ['616 Patent, Col. 3, lines 26-29.]

C. Conclusion

Applicant respectfully requests reconsideration of the current rejection of the claims now pending in this application in view of the above amendments, remarks and arguments. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, applicant respectfully requests a telephone interview. Attorney for the applicant may be reached at the number listed below.

Respectfully Submitted,

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